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| KEVIN L. RUSSELL<br>CHERNOFF, VILHAUER, MCCLUNG & STENZEL LLP<br>1600 ODS TOWER<br>601 SW SECOND AVENUE<br>PORTLAND, OR 97204 |             |                      | EXAMINER<br>CZEKAJ, DAVID J |                        |
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* GEORGE R. BORDEN, IV, JEFFREY B. SAMPSELL,  
and RICHARD QIAN

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Appeal 2011-000809  
Application 09/505,449  
Technology Center 2400

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Before MAHSHID D. SAADAT, DENISE M. POTHIER, and  
JASON V. MORGAN, *Administrative Patent Judges*.

MORGAN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

## INTRODUCTION

Appellants have filed a paper under 37 C.F.R. § 41.52(a)(1) requesting that we reconsider our decision of August 26, 2011, wherein we affirmed the Examiner's rejection of claims 1 – 20. Appellants' request is denied.

## DISCUSSION

Appellants contend (Reh'g Req. 3) that their arguments were exclusively addressed to limitation (c) of independent claim 1: "receiving a user selection of an object of interest in at least one frame of said image while said object tracking system is activated and while said image is being automatically increased in magnification in response to said initiating said tracking system." Appellants contend that the Board missed addressing this limitation (Reh'g Req. 4) and that the Examiner does not cite to Ito or Loveland as disclosing this limitation (Reh'g Req. 5).

Contrary to Appellants' contentions, both the Examiner and the Board addressed limitation (c). The Examiner acknowledged that Ito was deficient with respect to limitation (c), noting the apparatus of Ito "lacks . . . selecting an object of interest as claimed" (Fin. Rej. 2; Ans. 3 – 4) or the recited "receiving a user selection of an object of interest." However, the Examiner showed how Loveland's teachings cure this deficiency and, when combined with Ito, teaches the recited limitation (c) in claim 1 (Fin. Rej. 2 – 3; Ans. 4).

The Board agreed with the Examiner's findings, noting that "the *combination* of Loveland and Ito teaches or suggests the concept of a user selecting an object of interest (as taught by Loveland) while the tracking system is activated (where the claimed tracking system is taught and suggested by Ito)" (Dec. 4 – 5) (emphasis added). As the Board made clear:

“Ito’s system automatically begins to magnify the object when the object enters the tracking screen” (Dec. 4). As such, the Board’s findings fully address limitation (c): receiving a user selection of an object of interest (Loveland teaches and suggests “the concept of a user selecting an object of interest”) in at least one frame of said image while said object tracking system is activated (Ito teaches and suggests an active tracking system that detects entering objects at column 7, lines 35 – 40 and 50 – 54) and while said image is being automatically increased in magnification in response to said initiating said tracking system (Ito’s tracking system teaches and suggest outputting a magnified picture as shown as contrasted between Figures 2A and 2B and as described at column 7, lines 41 – 49 and 60 – 65). Notably, these additionally cited passages in Ito only elaborate on column 12, lines 21 – 26 cited by the Examiner (*see* Ans. 3). Also, all these steps in Ito occur without any user input or selection.

Appellants further contend that:

[I]f the Board of Appeals is trying to argue automatic zooming can occur “on an object” without that object being “selected or designated”, such an assertion makes no sense; if no object has been designated as a target there would be nothing to automatically zoom in on. Finally, the contention that “contrary to Appellants’ assertions ... claim 1 does not require magnification occur without identifying an object” is puzzling. There was no such assertion. The Applicants merely noted that claim 1 requires that designation of an object occur during magnification – an assertion subtly different from the Board’s restatement, and one that cannot be reasonably disputed given the plain language of the claim. The Applicants then reasoned that, since both prior art references teach magnification as part of the tracking process that occurs after the object to be tracked has been

identified, the claimed step is not obvious. To date, neither the Examiner nor the Board of Appeals has addressed this simple argument.

(Reh’g Req. 4, n.1).

Contrary to Appellants’ contention, it is clear from the Decision that (1) there is no contradiction in the finding that the combination of Ito and Loveland teaches or suggests a system that automatically zooms in on an object of *potential* interest and allows for a user selection of an object of *actual* interest and (2) such a system encompasses the claimed invention. *See, e.g.*, Dec. 4 (stating “Ito’s entering object is not selected or designated by the user to be target (App. Br. 5), and claim 1 does not require magnification occur without identifying an object”). During *ex parte* prosecution, the USPTO determines the scope of the claims by giving the language the “broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). Because “applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (citing *Am. Acad.*, 367 F.3d at 1364).

The broadest reasonable construction of (1) elements (a) and (b) in the claimed invention includes an automatic designation of an object of potential interest (e.g., an entering object) that is automatically magnified *and* (2) element (c) includes manual designation of an object of actual interest during magnification. Thus, while limitation (c) includes “receiving a user selection *of an object of interest . . . while said object tracking system is*

activated and while said image is being automatically increased in magnification in response to said initiating said tracking system” (emphasis added), we find nothing in the claim recitations precludes that the activation of the object tracking system and the image magnification occurs in response to other objects entering a field of view (i.e., an object of potential interest as opposed to an object of actual interest).

Appellants further contend that:

In the present case, all claims are rejected under 35 U.S.C. § 103(a) which requires that an Examiner provide a reasoned explanation of obviousness, which in turn requires a demonstration that all claim limitations are either taught in the prior art, or if a limitation is not found in the prior art, an explanation as to why it is obvious in view of the prior art.

(Reh’g Req. 5).

The Board is allowed to respond to Appellants’ arguments using different language, or restating the reasoning of the rejection in a different way, so long as the evidence relied upon is the same and the “basic thrust of the rejection” is the same. *See In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976). For example, citing to a different portion of an applied reference, which “goes no farther than, and merely elaborates upon, what is taught by” the previously-cited portion of that reference relied upon by the Examiner, does not constitute a new ground of rejection. *See In re DBC*, 545 F.3d 1373, 1382 n.5 (Fed. Cir. 2008). Furthermore, “all that is required of the [Patent] [O]ffice to meet its prima facie burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice

requirement of [35 U.S.C.] § 132.” *In re Jung*, 637 F.3d 1356, 1363 (Fed. Cir. 2011).

Appellants do not persuasively show how the Decision changes the thrust of the rejection. As the Examiner said, “Loveland discloses ‘selecting an object of interest while the tracking system [taught by Ito] is activated and *while the image is being magnified* in response to initiating the system’” (Fin. Rej. 2 – 3; Ans. 4) (emphasis added). The Board agreed, clarifying that “Loveland is relied on only for the narrow teaching of giving the user of a tracking system the ability to select a desired object or ‘an object of interest’” (Dec. 5) and that Ito’s tracking of an object of potential interest includes “zooming in”—a feature that, when combined with Loveland, allows selection of a target of interest while the image is being magnified (*id.*). Given that the Examiner set forth the references relied upon in a sufficiently articulate and informative manner so that the basis of the rejection could be understood, and that the Board’s Decision does not change the thrust of the Examiner’s rejection, Appellants had both due notice and a fair opportunity to show error in the Examiner’s rejection.

## CONCLUSION

Based on the record before us now and in the original appeal, we have granted Appellant’s request to the extent that we have reconsidered our decision, but we deny Appellant’s request to make any changes therein. The request for rehearing is denied.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2011-000809  
Application 09/505,449

REHEARING DENIED

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